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EXAMINER

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ART UNIT	PAPER NUMBER
1733	

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

ab12

Office Action Summary

Application N .

09/927,890

Applicant(s)

JACINO ET AL.

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The newly recited claims 9-20 are replete with newly recited claim limitations that lack antecedent basis in the Specification. It is suggested to amend the Specification to provide antecedent basis for the claim limitations without adding new matter.

For example, claims 9 and 17 recite the limitation that “a plurality of intersecting lines of ridges extending into the thickness of the panel from the inner surface toward the outer surface.” This limitation has support in the originally filed figure 2, however antecedent basis should be provided in the Specification.

Claim 9, also recites, “at least one portion of the inner surface being free of lines.” This limitation has support in the originally filed figures and in the Specification as described by clear portions, however antecedent basis for this claim language should be provided in the Specification.

Claim 9 recites, “elongate gasket strips.” This limitation has support in the originally filed figures, however antecedent basis for this claim language should be provided in the Specification.

Claim 10 recites, “wherein the one portion of the inner surface free of lines separates the grid into two segments, one of said segments being larger than the other, whereby the panel may be cut along the one portion to provide two differently sized

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repair patches.” It appears as though Applicant has support for these limitation in the Specification on page 7 by reciting that the grid is separated into two parts by a border 15 and cutting the panel at the border and by the figures 1, 5, and 6 showing two parts with one size being larger than the other, however antecedent basis for this claim language should be provided in the Specification.

Claim 12 recites, “a second plurality of intersecting lines of ridges extending from the inner surface toward the outer surface, the second plurality of lines of ridges forming a grid pattern on the inner surface.” The original Specification provides support for these limitations by reciting on page 7 that a selection of round cuts 43-46 are provided on repair panel 40 and the figure 11 showing the cuts 44 and 43 with additional grid patterns to the pattern 41, however antecedent basis for this claim language should be provided in the Specification.

Claim 13 recites “multiple discrete pluralities of intersecting lines of ridges.” The original Specification provides support for these limitations by reciting on page 7 that a selection of round cuts 43-46 are provided on repair panel 40 and the figure 11 showing the cuts 44 and 43 with additional grid patterns to the pattern 41, however antecedent basis for this claim language should be provided in the Specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted, the claims are replete with newly added limitations and new matter. It is suggested to accompany future amendments with an indication of where support can be found in the original Specification for any and all newly added limitations.

Claims 9-20 all recite, "for repairing a damaged area of a vehicle lens." While the Specification provides support for the repair of an automobile lens, there is no support in the original Specification for the other types of vehicles encompassed by the term "vehicle", for example, airplanes. It is suggested to change back to --automobile--.

Claims 9 and 17 recite, "having a substantially uniform thickness". There is no support in the original Specification for the repair panel having a substantially uniform thickness.

Claims 9 and 17 recite, "suitable for withstanding external vehicular environmental exposure." There is no support in the original Specification for this limitation.

Claims 9 and 17 recite "a substantially flat inner surface." There is no support in the original Specification for this limitation.

Claim 9 recites, "including a plurality of elongate gasket strips of sufficient length to overlie a peripheral border of the inner surface." While there is disclosure of a

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method of applying multiple gasket strips around the border of a cut part of the repair panel, there is no disclosure in the original Specification for providing enough strips to overlie the peripheral border of the inner surface of the repair panel.

Claim 9 recites, "whereby the panel may be flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area and sealed along the peripheral border to the exterior surface of the lens or bulb housing after removal of the release sheets." While the Specification discloses that the repair panel is cut, the gasket strips are applied to the cut panel, release sheets on the gasket strips are removed to engage the cut panel over the damaged area, and the flexibility of a cut panel enables a liquid type seal on page 19, there is no disclosure for the limitations as currently recited.

Claim 11 recites that "the one portion of the inner surface free of lines comprises the peripheral border." While the Specification discloses a clear portion border 15 and clear portions 32 and 42. There is no support in the original Specification for this limitation.

Claim 12 recites that "the grid pattern of the second plurality being of different dimensions than the grid pattern of the first plurality, whereby the portion of the panel having an inner surface with a grid pattern most closely resembling that of the lens or bulb housing may be separated from the panel to provide a repair patch." There is no disclosure in the Specification for a second grid pattern having a different dimension than the first pattern or selecting a grid pattern that is most closely resembling that of the lens or bulb housing.

Claim 13 recites that "each plurality forming a differently dimensioned grid pattern on the inner surface." There is no disclosure in the original Specification for multiple discrete pluralities of intersecting lines of ridges having differently dimensioned grid patterns.

Claim 15 recites that "a first plurality of equidistantly spaced parallel lines and a second plurality of equidistantly spaced parallel lines extending perpendicular to the first plurality. The original Specification does disclose ridges that form a grid, however there is no disclosure as to the relationship between the spacing of the lines.

Claims 16, 20 recite that the "panel includes a colorant or tint selected from the group consisting of amber and red." While the original Specification discloses providing the panel in a selection of colors, usually clear amber and red on page 9, there is no disclosure of a colorant or tint in the panel.

Claim 17 recites, "the panel dimensioned to overly the damaged area." There is no support in the Specification for these limitations.

Claim 17 recites, " a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto, the adhesive layer being covered with a release strip." The Specification discloses providing gaskets with adhesive layers around a periphery of a patch to form a border with release strips on each strip and a separate panel where an adhesive layer 48 is on the back of the panel covered with a release paper 47 (page 8). However, there is no disclosure of a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered

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thereto with a release strip. It is suggested to clarify which embodiment is being claimed.

Claim 17 recites, "whereby the panel may be flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area and sealed to the exterior surface of the lens or bulb housing by removing the release strip and applying a compressive force to the outer surface of the panel." While the Specification discloses that the release sheets are removed to engage the cut panel over the damaged area, and the flexibility of a cut panel enables a liquid type seal on page 19, there is no disclosure for the limitations as currently recited.

Claim 19 recites, "the border of the inner surface of the panel surrounding the periphery is free of the grid pattern." There is no disclosure in the Specification for these limitations.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 9 and 17 are unclear by reciting "having a substantially uniform thickness". It is unclear what the scope of the limitation encompasses. That is, how uniform is substantially uniform?

7. Claims 9 and 17 are unclear by reciting, "suitable for withstanding external vehicular environmental exposure". It is unclear what the scope of the limitation

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encompasses. It is unclear how one of ordinary skill in the art would be able to determine the scope of what is "suitable" or not.

8. Claim 9 and 17 are unclear by reciting, "a substantially flat inner surface." It is unclear how one of ordinary skill in the art would be able to determine the scope of what is "substantially flat" or not.

9. Claim 9 is unclear by reciting, "including a plurality of elongate gasket strips of sufficient total length to overlie a peripheral border of the inner surface." It is unclear whether this limitation requires that each of the gasket strips are of a sufficient length to overlie a border of the inner surface or that the plurality of gasket strips together form sufficient length to overlie the border

10. Claim 9 is unclear by reciting, "whereby the panel may be flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area and sealed along the peripheral border to the exterior surface of the lens or bulb housing after removal of the release sheets." It is unclear how the exterior surface of the lens or bulb housing can overlie the damaged area. It is not completely clear as to whether the panel is sealed along the peripheral border. Furthermore, it is unclear how the panel is sealed by removing the release sheets of the gasket strips, as there is no recitation of placing the gasket strips on the panel. Finally, it is also unclear whether applicant is claiming a kit with a panel that is capable of being sealed to the lens or bulb housing or the end product of a panel sealed to the lens or bulb housing.

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11. Claim 9 recites the limitation "the release sheets" in line 12. There is insufficient antecedent basis for this limitation in the claim. It is unclear what sheets applicant is referring to. Clarification is required.

12. Claim 12 recites that "the grid pattern of the second plurality being of different dimensions than the grid pattern of the first plurality." It is unclear what dimensions are required by the claims, the width, the height, the length, the thickness, the spacing between the lines forming the grid, etc.

13. Claim 13 recites that "each plurality forming a differently dimensioned grid pattern on the inner surface." It is unclear what dimensions are required by the claims, the width, the height, the length, the thickness, the spacing between the lines forming the grid, etc.

14. Claim 17 is unclear by reciting, "the panel dimensioned to overly the damaged area." It is unclear what dimensioned is referring to, how the panel is dimensioned, what the dimensions are, etc.

15. Claim 17 is unclear by reciting, " a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto, the adhesive layer being covered with a release strip." The Specification discloses providing gaskets with adhesive layers around a periphery of a patch to form a border with release strips on each strip and a separate panel where an adhesive layer 48 is on the back of the panel covered with a release paper 47 (page 8). It is unclear which embodiment Applicant is referring to in the claims.

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16. Claim 17 is unclear by reciting, "whereby the panel may be flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area." It is unclear how the exterior surface of the lens or bulb housing can overlie the damaged area. Furthermore, it is unclear whether applicant is claiming a patch that is capable of being sealed to the lens or bulb housing or a combination of the patch sealed to the lens or bulb housing.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II (Clear Star Products, Inc. 1996) in view of Marshall (US Patent No. 5,569,346) as taken with Butt (US Patent No. 6,106,648).

Lens Saver II discloses a patch for repairing a damaged area of a vehicle lens or bulb housing, the lens or bulb housing having an exterior surface, the patch comprising a flexible translucent repair panel (grid deflector) having a substantially uniform thickness (see figures) and a substantially flat inner surface (see figures), a plurality of intersecting lines (see figures), the lines forming a grid pattern on the inner surface (see figures), the panel being dimensioned to overly the damaged area (step 6), the panel including a periphery, a border of the inner surface of the panel surrounding the periphery having an adhesive layer adhered thereto (the adhesive gasket covers the entire periphery of the panel), the adhesive layer being covered with a release strip (protective paper), whereby the panel may be flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area and sealed to the exterior surface of the lens or bulb housing by removing the release strip and applying a compressive force to the outer surface of the panel.

As to the repair panel being flexible, the grid deflector in Lens Saver II is considered to be flexible as it is used to cover damaged areas in curved lenses, therefore it is flexible enough to be curved to the shape of the lens. Furthermore, Marshall discloses known materials for forming grid deflectors (patterned plastic) which are also considered to be flexible (considering their materials and thickness). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector in Lens Saver II as a flexible panel as is considered known in the art as exemplified by Marshall in order to conform to the curved shape of the lens product.

It is noted that the claim is rejected based on the first adhesive gasket adhered to the inner surface of the grid deflector. It is also noted that in the steps as disclosed in Lens Saver II, the release strips of the adhesive layer are removed prior to applying to the grid deflector. However, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to apply the adhesive layer to the grid deflector prior to the application to the damaged area. There is no criticality in the order of the steps as disclosed. Only the expected results would be attained. Optionally, Marshall shows that it is known in the art to pre apply adhesive layers with release strips to grid deflectors prior to adhering to substrates (column 3, lines 40-41). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the first adhesive gasket to the inner surface of the panel as shown in Len Saver II as it would have been well with in the purview of one of ordinary skill in the art and further known in the art as shown by Marshall. Only the expected results would be attained.

As to the limitation that the repair panel including an outer surface suitable for withstanding external vehicular environmental exposure, it is unclear what the grid deflector in Lens Saver II is made of or its suitability towards external environmental exposure. (It is noted that these limitations were not described in the original Specification and it is unclear what the scope of the limitations of the suitability of the panel is). Marshall discloses a similar repair panel grid deflector known in the art (patterned plastic) that is of the same plastic material as that used for the outer layer (thermoplastic patch) which is assumed to have the suitable properties for withstanding external vehicular environmental exposure and therefore it is considered that the

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patterned plastic is also suitable for withstanding external vehicular environmental exposure. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector as shown in Lens Saver II of known materials in the art as exemplified by Marshall. Only the expected results would be attained.

As to the limitation that ridges extending into the thickness of the panel from the inner surface toward the outer surface, Lens Saver II does not specifically disclose the manner of providing the grid on the grid deflector. Marshall shows that it is known in the art to provide grid patterns on grid deflectors by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges extending into the thickness of the panel from the inner surface toward the outer surface. It is well known to provide lenses and in particular repair patches for lenses with ridges extending into the thickness of the panel from the inner surface toward the outer surface to forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has a patterned inner surface that is flat with ridges extending into the thickness of the panel from the inner surface toward the outer surface that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Lens Saver with a pattern by tooling as shown in Marshall where the pattern of ridges extending into the thickness of the panel from the inner surface toward the outer surface in order to form a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

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As to claim 18, Lens Saver II does not specify whether the adhesive layer is translucent. However, it is well known in the repair art of lenses to provide translucent adhesive in order to maintain the translucency of the lens. For example, Marshall discloses the known repairs are translucent and it is desired in this art to provide a translucent repair including using translucent adhesives (column 1, lines 1-45; column 3, lines 59-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer as shown in Lens Saver II that is translucent as is considered well known in the repair art for repairing lens parts and further exemplified by Marshall in order to provide a translucent repaired product.

As to claim 20, Lens Saver II does not specifically recite the colors of the repair panel (grid deflector). It is well known in the art to provide grid deflectors from the typical colors of the lens products to be repaired such as amber or red. For example, Marshall discloses providing colorant or dye to the plastic in patterned repair panels (patterned plastic) in a variety of colors including amber and red in order to match the color of the lens (column 2, lines 40-52 and column 3, lines 11-17).

20. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II in view of Marshall as taken with Butt as applied to claim 17 above, and further in view of Boyce (US Patent No. 2,833,327).

It is unclear whether the repair panel in Lens Saver II has a border surrounding the periphery that is free of the grid pattern. It is noted that the last figure on the first page may show a border around the panel. Regardless, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide a

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border free from the grid pattern as a design choice of one of ordinary skill in the art.

Only the expected results would be attained. Furthermore, it is well known in the repair art to provide a repair patch from a repair panel that includes multiple patches for repair in order to give the customer choice in the size or shape of repair. For example, Boyce discloses a repair panel that provides plural repair patches separated by borders around the peripheries of the patches (column 1, lines 55-60; column 3, lines 4-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Lens Saver II with a border around the individual patches free of the grid pattern in order to provide the user with multiple repair patches as is well known in the repair art and further exemplified by Boyce. Only the expected results would be attained.

21. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lens Saver II (Clear Star Products, Inc. 1996) in view of Marshall (US Patent No. 5,569,346) as taken with Butt (US Patent No. 6,106,648) and further in view of Boyce (US Patent No. 2,833,327).

Lens Saver II discloses a kit for repairing a damaged area of a vehicle lens or bulb housing, the lens or bulb housing having an exterior surface, the kit comprising a flexible translucent repair panel (grid deflector) having a substantially uniform thickness (see figures) and a substantially flat inner surface (see figures), a plurality of intersecting lines (see figures), the lines forming a grid pattern on the inner surface (see figures), the kit further including a plurality of elongate gasket strips (adhesive gaskets) of sufficient total length to overlie a peripheral border of the inner surface (see figures), each gasket

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strip including an adhesive layer covered by a release sheet (paper backings), whereby the panel is capable of being flexed to conform to the contour of the exterior surface of the lens or bulb housing overlying the damaged area (see disclosure on page 2 for curved or contoured housings) and sealed along the peripheral border to the exterior surface of the lens or bulb housing after removal of the release sheets (steps 8-10).

As to the repair panel being flexible, the grid deflector in Lens Saver II is considered to be flexible as it is used to cover damaged areas in curved lenses, therefore it is flexible enough to be curved to the shape of the lens. Furthermore, Marshall discloses known materials for forming grid deflectors (patterned plastic) which are also considered to be flexible (considering their materials and thickness and ability to conform to curved lenses). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector in Lens Saver II as a flexible panel as is considered known in the art as exemplified by Marshall in order to conform to the curved shape of the lens product.

As to the limitation that the repair panel including an outer surface suitable for withstanding external vehicular environmental exposure, it is unclear what the grid deflector in Lens Saver II is made of or its suitability towards external environmental exposure. (It is noted that these limitations were not described in the original Specification and it is unclear what the scope of the limitations of the suitability of the panel is). Marshall discloses a similar repair panel grid deflector known in the art (patterned plastic) that is of the same plastic material as that used for the outer layer (thermoplastic patch) which is assumed to have the suitable properties for withstanding

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external vehicular environmental exposure and therefore it is considered that the patterned plastic is also suitable for withstanding external vehicular environmental exposure. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the grid deflector as shown in Lens Saver II of known materials in the art as exemplified by Marshall. Only the expected results would be attained.

As to the limitation that ridges extending into the thickness of the panel from the inner surface toward the outer surface, Lens Saver II does not specifically disclose the manner of providing the grid on the grid deflector. Marshall shows that it is known in the art to provide grid patterns on grid deflectors by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges extending into the thickness of the panel from the inner surface toward the outer surface. It is well known to provide lenses and in particular repair patches for lenses with ridges extending into the thickness of the panel from the inner surface toward the outer surface to forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has a patterned inner surface that is flat with ridges extending into the thickness of the panel from the inner surface toward the outer surface that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Lens Saver II with a pattern by tooling as shown in Marshall where the pattern of ridges extending into the thickness of the panel from the inner surface toward the outer surface in order to form a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

As to the limitation that at least one portion of the inner surface of the repair panel is free of lines, it is unclear whether the repair panel in Lens Saver II has a portion that is free of the grid pattern. It is noted that the last figure on the first page may show a border around the panel free of lines. Regardless, it is well known in the repair art to provide a repair kit with a repair panel that includes multiple patches for repair in order to give the customer choice in the size or shape of repair. For example, Boyce discloses a repair panel that provides plural repair patches separated by borders (column 1, lines 55-60; column 3, lines 4-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Lens Saver II with a selection of inner surface portions or grid patches surrounded by borders free of grid lines in order to provide the user with multiple repair patches as is well known in the repair kit art and further exemplified by Boyce. Only the expected results would be attained.

As to claim 10, as discussed above, Boyce discloses borders that separate the panel into two segments of different shapes and sizes where one segment is larger than another and the panel is cut along the portion or border to provide differently sized patches. As to claim 11, the borders in Boyce are peripheral borders. As to claim 12, as discussed above, the panel in Boyce is separated by borders to provide patches of different shapes and sizes. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a grid deflector panel with multiple patches of different sizes or dimensions with grid patterns on each of the patches (thus providing differently dimensioned grid patterns). As to claim 13, as discussed above, Boyce

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discloses providing repair panels with multiple, discrete sized patches. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a grid deflector panel with multiple discrete patches of different sizes or dimensions with grid patterns on each of the patches (thus providing differently dimensioned grid patterns).

As to claim 14, Lens Saver II does not specify whether the adhesive layer is translucent. However, it is well known in the repair art of lenses to provide translucent adhesive in order to maintain the translucency of the lens. For example, Marshall discloses the known repairs are translucent and it is desired in this art to provide a translucent repair including using translucent adhesives (column 1, lines 1-45; column 3, lines 59-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer as shown in Lens Saver II that is translucent as is considered well known in the repair art for repairing lens parts and further exemplified by Marshall in order to provide a translucent repaired product.

As to claim 15, the grid pattern in Lens Saver II appears to be of a first and second plurality of equidistantly spaced parallel lines that are perpendicular to each other (see figures). Furthermore, it is well known in the art to provide such a grid pattern to repair parts for repairing lens products (see the examples of known patterns in Butt).

As to claim 16, Lens Saver II does not specifically recite the colors of the repair panel (grid deflector). It is well known in the art to provide grid deflectors from the typical colors of the lens products to be repairs such as amber or red. For example,

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Marshall discloses providing colorant or dye to the plastic in patterned repair panels (patterned plastic) in a variety of colors including amber and red in order to match the color of the lens (column 2, lines 40-52 and column 3, lines 11-17).

Response to Arguments

22. Applicant's arguments filed October 20, 2003 have been fully considered but they are not persuasive.

It is noted that it appears that Applicant's arguments tend to attack the inventions of the references by pointing out supposed deficiencies but do not generally argue what claim limitations are not shown or suggested by the prior art references.

Applicant argues on pages 8, 9 and 10 that the Marshall and Lens Saver II references disclose a two part/composite laminate patch that has an outer layer that is not flexible and is required to be heated. It is noted that the newly recited claims are rejected under Lens Saver II in view of Marshall and other references. It is further noted that Applicant's claims do not exclude a two part laminate patch and that the rejection is based on the grid deflector layer of the Lens Saver II reference. As to the flexibility of the repair panel or patch, the current rejections are based on the grid deflector panel as shown in Lens Saver II which is analogous to the patterned plastic in Marshall. The grid deflector panel is considered flexible and no different than Applicants. It is also noted that even though the rejections are not based on the outer repair panel layer that is heated, this panel is also considered to be flexible as it is able to conform to the curve of the lens in the same way as Applicants, the claims do not exclude heating the panel.

Applicant argues on page 11 that the "claimed structure" simplifies installation by not requiring a heating step and eliminate the steps of measuring, cutting and bonding the patterned sheet, provides a repair patch of reduced thickness, and removes the possibility of condensation, air bubbles, contaminants or foreign objects between the layers. The claims are currently kit claims and patch claims. There are no method claims. The claims do not exclude any method steps shown in the references. The claims as currently written also do not exclude a laminated patch.

Applicant argues on page 11 that Lens Saver II discloses an adhesive gasket that overlies the entire damaged area of the lens, not just a peripheral area of the patch. The claims as currently written do not exclude adhesive gaskets overlying the entire area of the patch.

Applicant argues on pages 12-14 that the claims 10-16 are allowable as being dependent upon claim 9 and further recites the limitations of the dependent claims. The limitations of the dependent claims are all addressed above.

Applicant argues in reference to claim 17 on page 15 that the references disclose repair panels that are required to be heated, a lamination of inner and outer panels, and adhesive overlying the entire inner surface of the patch. As discussed above, non of these arguments are excluded by the claim limitations as currently recited.

Applicant argues on pages 15-16 that the claims 18-20 are allowable as being dependent upon claim 17 and further recites the limitations of the dependent claims. The limitations of the dependent claims are all met by the references as addressed above.

Conclusion


23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Additionally, Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on October 20, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a) and See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.



Gladys J. Piazza Corcoran
Examiner
Art Unit 1733

GJPC
January 7, 2004